

REMARKS

Claims 1-22 are pending in this application. Claims 13-22 stand withdrawn. Claims 1, 13, 15 and 22 are the independent claims. By this Amendment, claim 6 is cancelled without prejudice or disclaimer. Claims 1, 2, 4, 5, 9, 10 and 19 are amended. No new matter is added.

Restriction Requirement

Applicant again traverses the restriction of the claims. The Examiner appears to interpret PCT Rule 13.2 as indicating that if there is a single feature different among the claims that there is no unity of invention. However, such an interpretation is incorrect. Rather, PCT Rule 13.2 recites that the requirements of unity of invention shall be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” means those features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. In other words, when a single special technical feature is shared, there is unity of invention.

Applicant asserts that at least Groups I, III and IV share a least one special technical feature. For example, claim 1 of Group I recites “wherein seam contact surfaces of the can jacket and the closure member that are pressed against each other prior to the welding of the closing seam are embodied as ring-shaped circumferential edge regions which are at least one of expanded and necked down in a direction along the can axis for the welding of the closing seam, the method comprising: pushing the can jacket and the at least one closure member together, with the edge regions getting to a stop position, wherein from the end faces of the two edge regions one is positioned on the inside and one on the outside of the can body; forming the closing seam when two air-free adjoining seam contact surfaces are at a stop position against each other.” Claim 15 of Group III recites corresponding features. Therefore, Groups I and III share at least one special technical feature. Moreover, as claim 21 of Group IV specifically incorporates all of the features of claim 1, the claim must share at least one special technical feature with Groups I and III.

As at least Groups I, III and IV share special technical features, withdrawal of the restriction is required.

Drawings

The drawings are objected to for allegedly failing to show all of the features of dependent claim 6. As claim 6 is cancelled, the objection is moot. Further, the “hose element” of claim 6, which is now recited in independent claim 1, is shown at least at Fig. 21b and described at paragraph [0033] of the Substitute Specification. Therefore, withdrawal of the objection is respectfully requested.

Allowable Subject Matter

As claims 6 and 8-10 are only rejected under 35 USC §112, second paragraph, Applicant understands that upon removal of the antecedent basis issues, the claims will be in condition for allowance.

Claim Rejections Under 35 USC §112

Claims 1-12 are rejected under 35 USC §112, second paragraph, for antecedent basis issues. As the claims are amended to remove all of the antecedent basis issues referred to in the Office Action, withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 USC §103

Claims 1-5, 7, 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over EP Patent No. 0,200,098 to Hauser in view of U.S. Patent No. 3,337,944 to Morris. The rejection is respectfully traversed.

In rejecting the claims the Examiner relies on a foreign language reference. Applicant respectfully reminds the Examiner that when relying on a foreign language document in support of a rejection, “if the document is in a language other than English and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection (MPEP §706.02). Although paragraphs [0006]-[0009] of Applicants Substitute Specification describe certain features of Hauser, the Examiner’s reliance on the reference is none the less improper as the Examiner relies on more than the English language description provided in the Substitute Specification in rejecting the claims. Accordingly, the rejection is improper on its face and should be withdrawn.

Evidence of the improper reliance on the foreign language document may be found, for example, in the Examiner’s interpretation of Fig. 8 of Hauser as allegedly showing “edge regions

getting to a stop position.” There is nothing in the English language description in the specification of the present application that would support the Examiner’s interpretation. Similarly, there is nothing in the English language description in the specification of the present application that would support the Examiner’s interpretation of reference number 47 being an “external mold.” Further, the Examiner’s interpretation of element 47 is inconsistent with the remainder of the rejected claim. For example, interpreting the element 47 as an “external mold” is incorrect because, as may best be interpreted from Fig. 16 showing element 47, the element 47 is on the inside of the can and therefore a hose element could not be inserted into the can and expanded to press the can wall against the external mold. In other words, the interpretation of Hauser is inconsistent with the claim language.

It is also admitted in the Office Action that Hauser fails to disclose or suggest that the can jacket is produced from a flat material. In an effort to overcome this admitted deficiency, it is alleged that one of skill in the art at the time of the invention would have modified Hauser according to the teachings of Morris. However, even were such a combination made, the resulting method would still not be rendered obvious because Morris fails to overcome the above deficiencies of Hauser.

Because the reliance on Hauser is improper and because Morris fails to overcome the deficiencies of Hauser, a *prima facie* case of obviousness has not been established. As such the rejection must be withdrawn. Further, as the combination of references fails to disclose or suggest each and every feature recited in the rejected claims, withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick, Reg. No. 41,018, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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